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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/719,571	09/25/96	ANDERSON	D A-63899-1

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EXAMINER

GRUN, J

ART UNIT

PAPER NUMBER

1641

12

DATE MAILED:

05/17/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action	Application No. 08/719,571	Applicant(s) ANDERSON
	Examiner James L. Grun, Ph.D.	Group Art Unit 1641

THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) expires _____ months from the mailing date of the final rejection.
- b) expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

Appellant's Brief is due two months from the date of the Notice of Appeal filed on 30 Apr 1999 (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on 30 Apr 1999 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

The proposed amendment(s):

- will be entered upon filing of a Notice of Appeal and an Appeal Brief.
- will not be entered because:
 - they raise new issues that would require further consideration and/or search. (See note below).
 - they raise the issue of new matter. (See note below).
 - they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

Applicant's response has overcome the following rejection(s):

prior rejections: under 35 USC 112, 1st para.; under 35 USC 102/103 over Martucciello et al; and under 35 USC 103 over Hesketh in view of others would be obviated upon entry of the proposed amendments.

Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached.

The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: _____

Claims objected to: _____

Claims rejected: 1, 2, 4-8, and 12-15

The proposed drawing correction filed on _____ has has not been approved by the Examiner.

Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____.

Other

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ADVISORY ACTION NOTE:

The request for reconsideration filed 30 April 1999 has been fully considered but does NOT place the Application in condition for allowance because Applicant's arguments were not found persuasive and the claims remain rejected for reasons of record.

The amendment filed 03 August 1998 remains objected to under 35 U.S.C. § 132 because it introduces new matter into the specification. Notwithstanding Applicant's priority claim and arguments drawn thereto, as set forth previously, unless expressly incorporated by reference in the original non-provisional disclosure, the disclosure of the Provisional Application does not form part of the original disclosure of the Non-provisional Application. Applicant is required to cancel the new matter, i.e. the additional columns and data added to Table 2, on page 24, and to Table 3, on page 30, which are not found in the specification as originally filed.

Claims 1-2, 4-7, and 12-15 remain rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 1-2, 4-7, and 12-15, the metes and bounds of what is or is not encompassed by a "RET antigen" remain entirely unclear. Applicant urges that the specification discloses that all of a RET sequence or a "part" thereof "may be used as a RET antigen". This is not found persuasive because the claims are not limited to RET or a fragment

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thereof and the metes and bounds of what else may be encompassed by recitation of a “RET antigen” cannot be determined from this inclusive definition. Applicant urges that the specification teaches that the sequence of RET is known, reported in the literature, and is incorporated by reference. If the sequence is essential, the incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Claims 1-2, 4-8, and 12-15 are rejected: under 35 U.S.C. 102(f)/(g) for reasons of record; and, under 35 U.S.C. 102(a) as being clearly anticipated by Lo et al (Neuron 15: 527-539, 1995) for reasons of record. Applicant’s indication that documents in compliance with the requirements of 37 C.F.R. § 1.48 are in preparation is noted.

Claim 8 is rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Stemple et al (Cell 71: 973-985, 1992) for reasons of record. Applicant’s arguments drawn to the initially isolated population of the reference were not found germane or persuasive with regard to the cloned cells of the reference noted in the rejection. Applicant’s arguments were also not found persuasive because the definition of neural progenitor cells includes mixtures of cells and is not limited to a substantially pure single cell type as argued.

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Claim 8 is rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Vescovi et al for reasons of record.

Claim 8 is rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Reynolds et al (Soc. Neurosci. Abstr. 18: 1107, Abstract 467.3, 1992) for reasons of record.

Claim 8 is rejected under 35 U.S.C. § 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Boss et al (US 5,411,883) for reasons of record.

Applicant's arguments filed 30 April 1999 have been fully considered but they are not deemed to be persuasive as there remains no factual evidence of a difference between what is disclosed in the references and what is instantly claimed.

Claims 1-2, 4-8, and 12-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lo et al (Perspectives Dev. Neurobiol. 2: 191-201, 1994), Stemple et al (Dev. Biol. 159: 12-23, 1993), Stemple et al (Cell 71: 973-985, 1992), and Martucciello et al for reasons of record.

Again, in response to Applicant's reiterated previous arguments that RET expression helps identify the lineage of neural crest stem cells, the fact that Applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). The Examiner would again note that Applicant

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does not describe and is not claiming a method for identifying the lineage of neural crest stem cells, only a method of neural progenitor cell enrichment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Grun, Ph.D., whose telephone number is (703) 308-3980. The examiner can normally be reached on weekdays from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, James C. Housel, SPE, can be reached on (703) 308-4027. The fax phone numbers for official communications to Group 1640 are (703) 305-3014 or (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

JL
James L. Grun, Ph.D.
May 13, 1999

Christopher L. Chin
CHRISTOPHER L. CHIN
PRIMARY EXAMINER
GROUP 1800-1641